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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/701,288	11/28/2000	Rudolf Ritter	PM275385	8925

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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ALEXANDRIA, VA 22314

EXAMINER

MCCLELLAN, JAMES S

ART UNIT PAPER NUMBER

3627

DATE MAILED: 02/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/701,288

Applicant(s)

RITTER ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Request For Reconsideration

1. Applicant's submittal of an amendment was entered on November 25, 2003, wherein: claims 1-17 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 1, 2, 4, 6, 7, 9, 11, 12, 15, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over International Publication No. WO 98/34203 (WO '203) in view of U.S. Patent No. 6,250,557 (Forlund et al.)

In regards to independent **claim 1**, WO '203 discloses a payment transaction method between a customer with a portal mobile device (412, see Figure 8) and a service point, comprising: determining a total transaction (see last paragraph of page 11) to be paid and a transaction identification assigned to the total transaction amount (see Figure 6, 200) at a payment terminal of the service point, informing the customer about the total transaction amount (see last paragraph of page 11) and the transaction identification (200), wherein, the payment terminal (414), during determination of the transaction identification; the payment terminal (414) transmits a payment request (200) which comprises a service point identification (inherent) and

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total transaction amount (inherent), via a second contactless device interface (426) to the mobile device; and a payment record is prepared in the mobile device (412), the payment record including a linking of payment request to a customer identification (inherent in authorization of step 202) of the customer, and being transmitted (step 202) from the mobile device (412) via the mobile contactless device interface (424) to the payment terminal (414); **[claim 2]** during the transmission of the transaction identification, entered by the customer, from the mobile device (412) to the payment terminal (414) a sender identification is co-transmitted (it is inherent during a transaction that a transmission will provide identification of the sender), and wherein the payment terminal (414) transmits payment request to the mobile device (412) established through the sender identification; and **[claim 4]** in the mobile device (412) data about the type of payment are added to the payment record before transmission of the payment record to the payment terminal.

In regards to independent **claim 6**, WO' 203 discloses a payment transaction system comprising a plurality of portable mobile device (412, inherent that the system utilizes more than one device) and a plurality of payment terminals (414, inherent that the system utilizes more than one terminal) at a service point, wherein, each of the mobile devices (412) and the payment terminals (414) includes at least one processor (inherent) and one contactless device interface (424, 426) the mobile devices (412) and the payment terminals (414) communicate with one another via the contactless device interfaces, each of the payment terminals (2) includes a transaction identification module configured to determine the transaction identification for a payment transaction, each payment terminals (414) includes a payment request module configured to transmit a payment request, comprising a service point identification (inherent) and

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the total transaction amount of the payment transaction, determined through the received transaction identification, via a second contactless device (426) to the mobile device (412) from which the transaction identification was received, and each of the mobile devices (412) includes a payment record module configured to prepare a payment record comprising a payment request (202), received by the mobile device (412) from a payment terminal (414), and a customer identification of the respective customer, and transmits the prepared payment record via the contactless device (424) to the payment terminal from which the payment request was received; **[claim 7]** the mobile devices (412) each comprise means to co-transmit a sender identification (it is inherent that sender identification is sent such that the payment terminal can identify the customer) when transmitting the transaction identification, entered by the customer, to the payment terminal (414) and wherein the payment request module comprises means to transmit the payment request to the mobile device (412) determined through the sender identification; **[claim 9]** the payment record module comprises means to add to the payment record data on the type of payment (see Figure 3) before transmission of the payment record to a payment terminal (414).

Regarding **claims 11 and 12**, WO '203 discloses a method of performing a payment transaction as described above in detail for similar limitations in claims 1, 2, 6, and 7.

Regarding **claims 15 and 16**, WO '203 discloses a system for performing a payment transaction as described above in detail for similar limitations in claims 1, 2, 6, and 7.

Regarding claims 1, 6, 11, and 17, WO '203 discloses wireless communication between the mobile unit and the payment terminal but fails to disclose the payment terminal sending a

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transaction identification and receiving it returned by the mobile unit before the payment terminal sends a transaction request.

Forslund et al. discloses a payment center sending a transaction identification (see column 4, lines 45-47) and receiving it returned by a mobile unit before the payment terminal sends a transaction request (see column 4, lines 57-61 and the paragraph bridging columns 4-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203 with preemptive transaction identification steps taught by Forslund et al., the additional step of identifying the transaction identification prior to the transaction request provides the mobile user with the desired ability to determine when the transaction will occur.

4. Claims 3, 8, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '203 in view of Forslund et al. in view of Official Notice.

WO '203 in combination with Forslund et al. fail to expressly disclose increasing wireless transmitting power between the two communication interfaces. The Examiner takes Official Notice that it is old and well known to increase transmitting power between two communication devices when contact is not originally available.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203's modified device with transmission power increase as is well known in the art, because increasing transmission power will increase the overall range of communication between the two devices and thereby improve overall operation of the communication system.

U.S. Patent No. 5,943,610 (Endo) is cited as evidence that it is old and well known to increase transmitting power between two communication devices when contact is not originally available (see ABSRACT).

5. Claims 5, 10, 14, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over WO '203 in view of Forslund et al. as applied to claim 1, 6, 11, and 15 above, and further in view of U.S. Patent No. 6,016,476 (Maes et al.).

WO '203 in combination with Forslund et al. show all the claimed elements as set forth above except for the use of a biometrics feature for identifying a user.

Maes et al. teaches the use of a biometrics feature for identifying a user during an electronic transaction (see sensor 40 in column 5, lines 54-67).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify WO '203's modified device with a biometric sensor as taught by Maes et al., because a biometric sensor provides a secure means of identifying the user, wherein reducing the likelihood of an improper transaction.

Response to Arguments

6. Applicant's arguments November 25, 2003 have been fully considered but they are not persuasive.

On page 2, 5th paragraph, Applicant argues that the combination of WO '203 and Forslund fails or suggest the concept of transmitting a transaction identification including terminal identification from a terminal to a mobile device and the retransmitting the transaction identification back to the terminal from the mobile device. More specifically, on page 3, Applicant argues that WO '203 does not disclose the transmitting of transaction identification

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including a payment terminal identification. After careful review of the WO '203, the Examiner maintains the 35 U.S.C. § 103 rejection (WO '203 and Forslund) of independent claims 1, 6, 11, and 15. WO '203 discloses several forms of communication between the merchant register and the user's mobile device including infrared and cellular telephone. WO '203 discloses an embodiment wherein a user's mobile phone is communication with a phone connected to a merchant register (see Figure 9). In order for communication to occur between the user's mobile device the merchant's phone connected to the register, the merchant register terminal phone must include an identification such that signals from the user will know where to be sent.

On page 4, Applicant attempts to traverse the Examiner's rejection of claims 3, 8, and 13 that relies on an assertion of Official Notice. Applicant's traversal is inadequate, as set forth in M.P.E.P. 2144.03 C, because Applicant failed to specifically point out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. See 37 CFR 1.111(b). See also *Chevenard*, 139 F.2d at 713, 60 USPQ at 241 ("[I]n the absence of any demand by appellant for the examiner to produce authority for his statement, we will not consider this contention."). A general allegation that the claims define a patentable invention without any reference to the examiner's assertion of official notice would be inadequate. Additionally, the common knowledge or well-known in the art statement is taken to be admitted prior art because Applicant's traversal was inadequate. It is noted that Applicant merely suggested that the Examiner assertion may not have been "old and well known" to an ordinarily-skilled artisan at the time of Applicant's invention, but failed to state why the noticed fact is not considered to be common knowledge. Despite Applicant's

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inadequate traversal, the Examiner cited evidence (Endo) to support the Examiner's assertion of Official Notice.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

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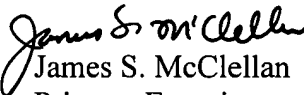
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Commissioner of Patent and Trademarks
Washington D.C. 20231

or faxed to:

(703) 872/9306 (Official communications) or
(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
January 29, 2004